UNITED STATES PATENT AND TRADEMARK OFFICE

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			EXAMINER
5073	7590	11/27/2009	MCCORMICK, GABRIELLE A

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NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 October 2009*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-9,12-17 and 20-25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4-9, 12-17 and 20-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   This action is in reply to the amendment filed on October 30, 2009.

2.   Claims 1, 9, 17 and 25 have been amended.

3.   Claims 1, 4-9, 12-17 and 20-25 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 9 and 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.   Claim 9 has been amended to recite that the system comprises "a plurality of service providers each having a network address and coupled to a communication network, techniques for interfacing with the feature interfaces, a plurality of feature interfaces providing access to a service and a plurality of service descriptors...".

7.   As currently worded, the "plurality", "techniques", "plurality" and "plurality" appear to be separate components of the system. Previous recitations of claim 9 were clear that the plurality of service providers included the pluralities of interfaces and descriptors. Therefore, the relationship between these limitations and the plurality of service providers is unclear.

8.   Further, the first recitation of "feature" is preceded by "the" and therefore lacks proper antecedent basis.

9.   With respect to all previous rejections under 35 USC 112, the Examiner has carefully considered Applicant's arguments and has been persuaded. Accordingly, the previous rejections are withdrawn.

Previous Claim Rejections - 35 USC § 101

10.   Applicant's amendments to claims 1 are sufficient to tie the method to a particular machine. The service register is now coupled to a communications network. When accessed, a particular machine is inherently required.

11.   The amendments to claim 9 are sufficient to clarify that service providers do not encompass human beings.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13.   <u>Claims 1, 4-7, 9, 12-15, 17, 20-23 and 25</u> are rejected under 35 U.S.C. 103(a) as being unpatentable over Das et al. (US Pub. No. 2003/0023499, hereafter referred to as "Das") in view of Vashistha et al. (US Pub. No. 2001/0051913, hereafter referred to as "Vashistha").

14.   **Claims 1, 9, 17 and 25:** Das discloses

- *a plurality of business function requirements;*   (P[0047]: "short or long term strategic purchasing policy rules")

- *accessing a service registry of a plurality of service providers coupled to a communications network;* (P[0065])

- *for each of the identified service providers:*

- *communicating with the service provider to determine feature interfaces for interacting with the service provider;* (P[0025]: the Network is the medium for communication links between devices and computers; P[0026]: servers provide data and applications to clients; P[0027]: Internet is gateway for communication. It is inherent in communicating via the Internet between purchasers and sellers (i.e., service providers) that interfaces for interacting with the service providers are communicated. Additionally, P[0085] begins the description of the system from the sellers' (service provider's) perspective. P[0106]: interfaces features are listed including data collection and storage; transaction record storage; on-line catalog; negotiation; sales completion and tracking; P[0050]: "services" are identified, therefore, service providers comprise the vendors of P[0066]; P[0043]: vendor selection and price negotiations are made automatically, thus feature interfaces for interacting with the service provider are inherent in the network-based system)

- *the service provider providing at least techniques for interfacing with the feature interfaces;* (P[0106]: service provide feature interfaces are listed, including an on-line catalog, a negotiation engine and a sale completion device. P[0102]: the provider has a Web storefront including online catalog and shopping cart system. P[0103]: invention includes processes (i.e., techniques) for making the sale including instructions for verifying and accepting payment. In P[0087], selling policy rules include preferred payment methods, therefore, the instructions for verifying and accepting payment would include preferred payment methods. The process for making the sale would include a technique for interfacing with a feature interface when the preferred payment methods are provided to the purchaser in order to verify and accept payment. P[0110] discloses that purchasers request information about products in the catalog. This further describes a technique for interfacing as the provider provides the means for the purchaser to make the request. P[0111]: negotiations involve transaction messages sent to and received from the purchaser, thus the provider sends a message to the purchaser during negotiation.)

- *accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider;* (P[0068] negotiations are conducted using the internal rules and parameters where price and time that a product is needed are factors that are negotiated, therefore, in order to negotiate around these factors, the service provider must at least have service descriptors that disclose pricing and availability. P[0050]: parameters, including price, quantity, delivery times and quality measures are used to negotiate the purchase from sellers, therefore, negotiation involves determining descriptors provided by the provider. P[0052]: vendors are compared based on price and quality, thus, price and quality are disclosed as descriptors.)

- *determining whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements;* (P[0047]: rules include rank ordering for calculating tradeoffs among different product or vendor attributes and rank ordered lists of preferred vendors (i.e., satisfactory) and P[0052]).

- *negotiating a plurality of variable service descriptors* (P[0050]: Das discloses parameters for negotiating the purchases from sellers using variable service descriptors, including price, quantity, allowable substitutions, order size and delivery times)

- *ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.* (P[0047]: rules include rank ordering for calculating tradeoffs among different product or vendor attributes (i.e., service descriptors) and rank ordered or weighted lists of preferred vendors.)

- authorizing performance of the service (P[0073]: purchase order is transmitted to selected supplier, thus a third feature interface is inherent in the transmission of the PO.).

15.   Das does not explicitly disclose whether a feature interface is a first, second or third, however, Das discloses an automated system over a network, such as the Internet, that includes vendor selection (determination of service descriptors describing a service is inherent in vendor selection); negotiation (P[0043]) and transmission of a PO (authorization) (P[0073]). Whether a feature interface is first, second or third is **nonfunctional descriptive data** and is not functionally

involved in the steps recited. **The determination of service descriptors, negotiation and authorization would be performed regardless of the description of the interface.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

16.   Das does not explicitly disclose *establishing an organizational database maintaining at least one business function description comprising a business function indicator; using the business function indicator to identify a network address for each service provider each having a service indicator matching the business function indicator.*

17.   Vashistha, however, discloses a registration module for buyers and providers that includes a buyer (i.e., organizational) database. Buyer and supplier profiles are entered such that the outsourcing system can suitably match buyers and providers, therefore, it is obvious that a business function indicator is disclosed that enables identification of the provider. (P[0036]); Buyers can be a department or entity within a company (P[0031]), therefore each entity will have a *business function indicator* such as the name of the department. Further, Vashistha discloses RFPs with requirements and specifications (i.e., *business function requirements*) (P[0037]: "categories of the outsourcing elements captured within the RFP module can include various types...", thus the RFP module stores this data. The matching module uses data and criteria from buyers to match to data captured from providers so to identify only those providers meeting a minimum level of matching. (P[0038]: this discloses the functionality of determining a satisfactory level based on business function requirements where the provider is identified by the business function description. A service provider's network address is identified such that notification of qualified providers can be made via e-mail (P[0038]).

18.   Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an organizational database using business function indicators to identify a network address for each provider, as disclosed by Vashistha in the system disclosed by Das, for the motivation of providing a method that "enables buyers, i.e., companies that need

IT projects and/or services implemented and completed, to obtain end-to-end knowledge and support to initiate, decide and implement IT projects and services with providers…" (Vashistha; P[0029]). Das discloses the system and methodology for automatically making operational purchasing decisions in a data network using purchasing rules that evaluate possible vendors to identify a set of vendors from which the product or service may be obtained, with a final selection for purchase from one or more vendors using rules, information about the vendors and the results of negotiations. (Das; P[0013]). Therefore, both Vashistha and Das aim to accomplish the objective of matching buyers and providers using rule based decision making systems and methodologies, thus it is obvious to expand Das to include the features of Vashistha.

19.   Das does not disclose ranking based on the negotiations (and therefore ranking doesn't include the negotiated plurality of variable service descriptors).

20.   Vashistha, however, discloses ranking bids (P[0066]) following a discussion and bidding module which provides a mechanism for facilitating the collaboration between buyers and providers to obtain an improved understanding of the RFP, thus ranking follows negotiation.

21.   Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included ranking prior to final selection, as disclosed by Vashistha, in the system of Das for the motivation of selecting a provider. Ranking is an old and well known form of aiding decision making and Das discloses that the selection may be based on the results of the negotiation, as well as other factors where the lowest price is not necessarily the basis for selection. (Das; P[0080]). By scoring and ranking, as disclosed by Vashistha, these other factors are accorded a role in the automated decision making process of Das. It then becomes obvious to authorize performance of a service as disclosed by Das (P[0073]) by the highest ranking service provider. Das discloses authorizing the "selected" seller. The combination with Vashistha to rank makes it obvious that the selected seller would also be the highest ranking.

22.   **Claims 4, 12 and 20:** Das discloses a plurality of deal parameters and a negotiation threshold (i.e., "maximum acceptable price") (P[0047-0048]) and performing a negotiation via a "back-and-

forth sequence of offers and counteroffers" where each counteroffer is compared to rules to determine acceptability. (P[0068]).

23.   **Claims 5, 13, and 21:** Das provides notification/authorization by transmitting purchase orders to the selected vendors. (P[0073]) but does not disclose a highest ranking provider.

24.   Vashistha, however, discloses ranking bids (P[0066]) following a discussion and bidding module which provides a mechanism for facilitating the collaboration between buyers and providers to obtain an improved understanding of the RFP. (P[0064]. Vashistha also discloses providing a qualified list of providers following scoring and ranking, thus providing a notification identifying the highest ranking provider. (P[0063]).

25.   Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included ranking prior to final selection, as disclosed by Vashistha, in the system of Das for the motivation of selecting a provider. Ranking is an old and well known form of aiding decision making and Das discloses that the selection may be based on the results of the negotiation, as well as other factors where the lowest price is not necessarily the basis for selection. (Das; P[0080]). By scoring and ranking, as disclosed by Vashistha, these other factors are accorded a role in the automated decision making process of Das.

26.   **Claims 6, 14 and 22:** Das discloses retrieving a list of known vendors and additionally querying a directory to find new vendors to add to the list (P[0065]). Vendors are then negotiated with (P[0068]) until a selection is made and a purchase order transmitted (P[0073]). Das does not disclose a highest ranking between current and satisfactory service providers.

27.   Vashistha, however, discloses matching buyers to both providers the buyer currently uses and with a global network of providers where both buyers and providers are notified. (P[0038]). Vashistha further discloses providers are scored and ranked and the results provided in a qualified list of providers. (P[0063]). It is inherent in ranking that a highest ranking provider is identified, and therefore a notification of such is generated with the qualified list in P[0063].

28.   Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a highest ranking, as disclosed by Vashistha, in the system of Das for the

motivation of for the motivation of selecting a provider. Ranking is an old and well known form of aiding decision making and Das discloses that the selection may be based on the results of the negotiation, as well as other factors where the lowest price is not necessarily the basis for selection. (Das; P[0080]). By scoring and ranking, as disclosed by Vashistha, these other factors are accorded a role in the automated decision making process of Das.

29.   **Claims 7, 15 and 23:** Das provides notification/authorization by transmitting purchase orders (i.e., organization information) to the selected vendors. (P[0073]).

30.   **Claims 8, 16 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Das et al. (US Pub. No. 2003/0023499, hereafter referred to as "Das") in view of Vashistha et al. (US Pub. No. 2001/0051913, hereafter referred to as "Vashistha") in further view of Chun et al. (US Pub. No. 2002/0184527, hereafter referred to as "Chun").

31.   **Claims 8, 16 and 24:** Das/Vashistha discloses the limitations of claims 7, 15 and 23. Das discloses evaluating vendors to identify a set of vendors from which a service can be obtained. (Abstract). Das does not disclose payroll management, employee, payment or banking information.

32.   Chun, however, discloses that businesses outsource payroll management (P[0004]) that includes the exchange of data relating to human resources and payroll. (P[0025]). Data and information relating to employees, salaries (i.e., payment) and banking are inherently comprised in the data disclosed.

33.   Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included payroll management and data, as disclosed by Chun, in the system of Das for the motivation of providing an example of a service providing vendor.

Response to Arguments

34.   Applicant's arguments filed October 30, 2009 regarding the prior art rejections have been fully considered but are not persuasive.

35.   Applicant argues that Das does not disclose "accessing a first one of the feature interfaces of the services provider, the service descriptors comprising at least techniques for interfacing with the feature interfaces." (Remarks; P. 17).

36.   The Examiner notes that the amended claim language with respect to techniques is "communicating with the service provider to determine feature interfaces for interacting with the service provider, the service provider providing at least techniques for interfacing with the feature interfaces" (Claim 1).

37.   With regard to understanding the context of this limitation and to provide support, Applicant cites P. 16 of the specification as disclosing "general message structures for interfacing with service 18".

38.   The Examiner asserts that at P[0111], Das discloses that negotiations involve transaction messages that are sent to and received from the purchaser and therefore discloses a technique for interfacing with the negotiations interface.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action.   In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828.   The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812.   The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.   Status information for published applications may be obtained from either Private PAIR or Public PAIR.   Status information for unpublished applications is available through Private PAIR only.   For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/JOHN G. WEISS/
Supervisory Patent Examiner, Art Unit 3629